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09/757,765	01/10/2001	Joseph W. Hundley JR.		8420

7590

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EXAMINER

TOOMER, CEPHIA D

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 01/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

FD-2

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

See for example page 7, line 3, "acedic" should read -- acetic.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CAR 1.75(d)(1) and MPEP. § 608.01(o). Correction of the following is required: There is no support in the specification for the proportions of 15 to 30% or 16 to 26% hydrocarbon wax (claims 4, 5, 10); 1 to 10% of a filler material (claim 9); 0 to 0.505 biocide (claim 10); 10% polyvinyl acetate (claim 15), 0 to 20% polyvinyl acetate (claims 18 and 19); and high density coal (claim 20).

### *Re* **Claim Objections**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, 5, 7, 10, 11, 13, 14, 16 and 17 and their dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, it is not clear what constitutes "olefinic wax-like materials."

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Claim 4 is rejected because there is no antecedent support in claim 1 for proportions of the polyvinyl alcohol.

In claim 5, there is no antecedent support in the previous claims for the proportion of polyvinyl alcohol and the biocide.

Claim 7 should read -- A method -- and not "The method".

Claim 10 is rejected because it is not clear if 0.505 is percentage by weight.

Claim 11 is confusing. It is suggested that the claim be rewritten as follows: -- A method as claimed in claim 7 wherein the composition is applied to the material by spraying.--

Claim 13 is rejected because it is not clear to which Federal Air Quality Regulations the method complies.

For clarity, it is suggested that the terms "and including" be deleted and replaced with the terms -- further comprising -- (see claims 14, 16, and 17).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 16 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over JP

2000080356.

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JP teaches a spray agent for preventing fly dust formation and spontaneous ignition of coal. The agent comprises ethylene vinyl acetate copolymer, paraffin wax, polyvinyl alcohol, a surfactant and water (see abstract document in its entirety). JP teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, JP differs from the claims in that it does not specifically teach the claimed proportions. However, no unobviousness is seen in this difference because it is not inventive to determine the workable or optimum range of the components through routine experimentation.

In the second aspect, JP differs from the claims in that it does not specifically teach the claimed method. However, it would be reasonable to expect that JP teaches this method because it uses a similar composition in the same environment as the present invention.

Claims 1-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borenstein (US 5,437,722).

Borenstein teaches an aqueous emulsion comprising paraffinic wax, montan wax and polyvinyl alcohol (see abstract). The montan wax is present in the composition in an amount of about 1 to 200 parts, by weight, per 100 parts of paraffin (see col. 2, lines 12-19). The water makes up from 35 to 80% of the composition. The composition also contains alkali metal or ammonium hydroxides stabilizers (see col. 3, lines 18-20). The polyvinyl alcohol is at least 90% hydrolyzed polyvinyl acetate (see col. 3, lines 4-9). Borenstein teaches the limitations of the claims other than the differences that are discussed below.

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In the first aspect, Borenstein differs from the claims in that he does not specifically teach applicants intended use. However, intended use is given no patentable weight in claims that are directed to the composition per se.

In the second aspect, Borenstein differs from the claims in that he does not specifically teach the claimed method. However, it would be reasonable to expect that the composition of Borenstein would assist complete combustion of the material since Borenstein's method steps and Applicant's method steps are the same, i.e., the composition is applied to the material. Also, no unobviousness is seen in Applicant's mode of applying the composition because it is one of the logical ways of applying the composition and the skilled artisan would have recognized this.

The prior art made of record but not relied upon is cited for teaching method of treating coal by applying a binding solution to the coal.

Any inquiry concerning this communication should be directed to Cephia D. Toomer at telephone number (703) 308-2509.

C.D. Toomer/dh

January 8, 2002



Cephia D. Toomer

Patent Examiner-1714